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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,920	04/12/2001	Takakazu Tanaka	35.G2771	5232

5514 7590 05/13/2003

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EXAMINER

NOTE, JANIS L

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 05/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

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Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.
Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07(f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
- (b) ☐ they raise the issue of new matter. (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE:

see attached, paragraph 1

4. ☒ Applicant's reply has overcome the following rejection(s):
see attached, paragraphs 2 and c
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☒ affidavit, b) ☐ exhibit, and c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see paragraph B.3.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: _____
- Claim(s) objected to: _____
- Claim(s) rejected: 21-32
- Claim(s) withdrawn from consideration: _____
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☒ Other: attached

James L. Date
EXAMINER

1. The proposed amended claims 21 and 22 presented in the amendment filed after the final rejection in Paper No. 9 on May 2, 2003, raise rejections under 35 U.S.C. 112, second paragraph. The amended claims are missing a terminal period. It is not clear whether the claims are complete.

2. The rejection of claims 21 and 28 under 35 U.S.C. 112, second paragraph, set forth in the final rejection mailed Dec. 2, 2002, Paper No. 8, paragraph 6, has been withdrawn in response to applicants' comments in Paper No. 9, page 11, lines 16-21, that the term "triphenyl amine compound [recited in instant claims 21 and 28] is an amine group bonded to three phenyl moieties. The amine nitrogen atoms in compounds (CT-6) and (CT-8) . . . are bonded to three phenyl moieties. One phenyl moiety is part of a fluorenyl group. A fluorenyl group is a type of fused phenyl moiety."

3. The examiner's refusal to enter the amendment filed in Paper No. 9 renders applicants' arguments moot regarding said amendment. In addition, applicants' arguments with respect to the rejections of claims 21-32 under 35 U.S.C. 103(a) over the combined teachings of Ohkubo and Sasaki and the combined teachings Ohkubo and Kikuchi are not persuasive. As discussed in the rejections in the final rejection mailed on Dec. 2, 2002,

Paper No. 8, paragraphs 10 and 13, respectively, Ohkubo teaches an apparatus and process cartridge that comprises all the other components (including a contact charger) recited in instant claims 21 and 22. Neither Sasaki nor Kikuchi limits the type of electrophotographic apparatus used. As discussed in the rejections, Sasaki's triphenylamine compound 220 and Kikuchi's compound (19) meet the respective limitations of the chemical formulas of compounds CT-9 and CT-6 recited in instant claims 21 and 22. The prior art compounds are used for the same purpose as compounds CT-6 and CT-9 namely to transport charge in an electrophotographic photosensitive member. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." MPEP 2113 (8th edition, Rev. 1, Feb. 2003), citing In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Feb. Cir. 1985). Each of Sasaki and Kikuchi provides reason, motivation, and suggestion to a person having ordinary skill in the art to use its photosensitive member in the process cartridge or apparatus disclosed by Ohkubo. Thus, for the reasons set forth in the rejections, the combined teachings of

Ohkubo and Sasaki and combined teachings of Ohkubo and Kikuchi render obvious the process cartridge and apparatus recited in instant claims 21-32.

In addition, the showing in the instant specification fails to show that Sasaki's or Kikuchi's triphenylamine compounds are not the same or substantially the same as the triphenylamine compounds made by the method recited in the instant claims. First, the showing in the instant specification is not commensurate in scope with the instant claims. With respect to the rejection over Sasaki, the triphenylamine compound CT-9 is made by a preferred method which uses the preferred base, sodium tert-butoxide. See instant claims 27 and 32. With respect to the rejection over Kikuchi, the triphenylamine compound CT-6 is made by a preferred method which uses the preferred base, sodium tert-butoxide, and preferred phosphine compound, di-tert-butylphenylphosphine. See instant claims 25, 27, 30, and 32. Instant claims 21 and 22 recite that compounds CT-6 and CT-9 are synthesized from an amine compound and an aryl halide in the presence of a phosphine compound of formula (1) and a palladium compound. Thus, it is not clear whether the compounds CT-6 and CT-9 made by the method recited broadly in instant claims 21 and 22 are unobviously different from the compounds disclosed in the prior art. There is no objective evidence on the present record to show that the triphenylamine compounds CT-6 and CT-9 obtained

by the method recited broadly in instant claims 21 and 22 are unobviously different from the triphenylamine compounds disclosed in the prior art.

Second, with respect to the rejection over Sasaki, the showing in the instant specification does not provide a probative comparison to Sasaki. As discussed in the rejection in Paper No. 8, paragraph 10, Sasaki's triphenylamine compound 220, which meets the chemical formula of compound CT-9 recited in instant claims 21 and 22, is obtained by reacting diethyl-1,1-diphenylmethylphosphonate with 4-N,N'-bis(4-methylphenyl)amino-benzaldehyde in the presence of sodium hydride. Comparative examples 9 and 19 do not synthesize CT-9 by the method disclosed by Sasaki. There is no objective evidence on the present record to show that Sasaki's compound 220 is not the same or substantially the same as compound CT-9 made by the method recited in the instant claims.

Accordingly, the rejections over Sasaki or Kikuchi stand.